

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellants:	Craig Ullman et al.	Examiner:	Douglas Blair
Serial No.:	09/409,305	Group Art Unit:	2442
Filed:	September 29, 1999	Docket No.:	2050.132US1
Customer No.:	44367	Confirmation No.:	5182
Title:	ENHANCED VIDEO PROGRAMMING SYSTEM AND METHOD UTILIZING USER-PROFILE INFORMATION		

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**APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. 41.41**

MS Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This Reply Brief is provided in response to the Examiner's Answer (hereinafter, the "Answer"), mailed on September 29, 2009. Please consider the following remarks.

**ARGUMENT**

The Appellant has reviewed the Answer, and believes the statements in the Appeal Brief remain accurate and compelling. In responding to the Answer, the Appellant would like to further explore a selected few of the points raised by the Office. These points are directed to similarly-designated arguments presented by the Office in section "(10) *Response to Argument*" of the Answer.

***Point A. The Case Law Presented by Appellant is Relevant Because the Cited References Teach Away from Combination With Each Other***

The Appellant has set forth in detail in the Appeal Brief why the combination of references proposed by the Office is improper. In short, it is because the references teach away from use with each other at precisely the point (inheritance) where the Office uses attempts to combine them. As noted in the Appeal Brief "... if the strictly regulated use of inheritance, as taught by Kingdon, is added to the dependence on dynamic change taught by Rangan, an inoperative system results."

In reply, the Office asserts in the Answer that the "... Examiner does not feel that the case law citations made by the Appellant are relevant because they deal with references that teach

away from the claimed invention. The rejections of the Appellant's claims do not feature prior art that teaches away from the applicant's invention." However, the mere statement that the references do not teach away from each other is not evidence. Without more, the fact remains that an inoperative system results from the proposed combination, based on the teachings of the references.

To restate the case law presented in the Appeal Brief that is most pertinent to this point:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The CCPA has also noted that "[t]he court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings." *In re Spinnoble*, 160 USPQ 237, 243 (CCPA 1969)."

An inoperative system clearly changes "the principle of operation of the prior art invention being modified". Thus, "... the teachings of the references are not sufficient to render the claims *prima facie* obvious." See *In re Ratti*. Therefore, the Office has not met its burden with respect to establishing a proper *prima facie* case of obviousness, and the pending claims should be in condition for allowance.

***Point B. The Fact That References Can be Combined Does Not Mean That The References Should be Combined***

In the Answer, the Office states that "Kingdon is only relied upon to show that attributes taken from a larger group are considered it to be inherited. It is in the broad context of inheritance that Kingdon should be considered with respect to Rangan. The specific details of Kingdon are not relied upon in the rejection, but instead the explicit concept of inheritance that Kingdon shows is relied upon in the rejection."

The Office also states that "The Appellant's reasoning completely ignores the context in which the rejection is made." On the contrary. The context of the rejection is clear: it is apparent that the Office is acting to selectively incorporate various parts of Kingdon and Rangan to assemble a system which reads on the pending claims.

There is nothing wrong with the approach taken by the Office, up to a point. And that point is reached when the Office asserts that “One of ordinary skill in the art (a computer scientist) would clearly recognize that the teachings relied upon in the rejection could be used together ...”.

This is not the standard for establishing a *prima facie* case of obviousness. As noted in the previous point, the argument does not center around whether it is possible to combine the references. Rather, it is about whether it is legally proper to make such a combination. The position of the Appellant is this: whether or not the proposed combination is possible is irrelevant if it is not proper. And surely, suggesting a combination which is inoperative is not proper. In this case, the fundamental principles of operation promoted by the references are violated by making the proposed combination. Therefore, no proper *prima facie* case of obviousness has been established, and the claims should be in condition for allowance.

***Point C. The References do Not Provide All Claimed Elements***

As noted previously by the Appellant, the Office did not articulate in which references, and where in those references various elements recited in claims 150-183 could be found. This lack of specificity was finally remedied in the Answer, at least with respect to claims 150-157. However, the Office has still not set forth the location of the teachings with respect to various elements in several of the remaining claims. For example:

- With respect to claim 170: the Appellant was unable to find any teaching of “selecting content for at least one user based on examination of at least one other user profile” in any of the cited references.
- With respect to claim 171: the Appellant was unable to find any teaching of “wherein selecting content for at least one user further comprises selecting content for a group of users” in any of the cited references.
- With respect to claim 174: the Appellant was unable to find any teaching of “wherein selecting content for at least one user further comprises examining profiles of users in one or more groups of which the at least one user is not a member” in any of the cited references.

Without more, and for at least these reasons, no proper *prima facie* case of obviousness has been established, and these claims should be in condition for allowance.

***Point D. The Proper Context of the Rejection Includes Considering the Propriety of Combining the References***

In the Answer, the Office states that “The appellant has ignored the specific points brought up in this Examiner’s Answer and previous office letters ... about how the appellant is taking the rejection out of context.” However, the rejection has not been taken out of context. Rather, the rejection has been placed within its proper context, which according to the case law includes a consideration as to whether it is proper to combine the references. Since the modification suggested by the Office is clearly improper, no proper *prima facie* case of obviousness has been established, and the claims should be in condition for allowance.

In conclusion, for the reasons set forth above and in the Appeal Brief, it is improper to combine Kingdon and Rangan to reject claims 149-183 under 35 U.S.C. § 103(a). Therefore, the Appellant respectfully requests that this rejection be reversed, with allowance of the pending claims.

**CONCLUSION**

The Appellant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(210) 308-5677

Date NOVEMBER 30, 2009

By

/ Mark V. Muller /

Mark V. Muller

Reg. No. 37,509

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this ~~30th November 2009~~ 30th November 2009

John D. Gustav-Wrathall

Name

/ John D. Gustav-Wrathall /  
Signature